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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548

490 7590 12/20/2001

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,866

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Specification

The abstract of the disclosure is objected to because it fails to adequately describe the invention. Although abstracts are to be 150 words or less, the present abstract is too concise. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, claim 25 appears to contain the same limitation that claim 16 contains.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 16-25 and 34-35 in particular, the last paragraph of claim 16 and the limitations of claim 35 "wherein the first expansion strut has a longitudinal axis offset from" 'that of the second expansion column' lacks original support because this is not disclosed in Applicants' specification for an unexpanded stent.

Art Unit: 3738

With regard to claims 20-22, 25, 29, 30, and 31, the subject matter of these claims lacks original support wherein sections of the connectors were not originally disclosed or contemplated.

With regard to claims 26-33, lines 20-26 of claim 26 sets forth an equivalent limitation as that set forth in claim 16 as set forth in the earlier paragraph.

With regard to claim 26 and its dependent claims, on lines 33-35 of claim 26, the ratio of connector struts to expansion struts was not originally disclosed or contemplated, and thus, it is not seen how it has original support.

With regard to claim 28, the scope of "substantially the same width" was not originally disclosed and there was no guidance as to how the term "substantially" is to be interpreted. For this reason, the addition thereof constitutes new matter in that it extend to the claim a meaning outside the bounds of what was originally disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the language of the claims lacks clear antecedent basis from the specification such that it is not clear what structure or element of the specification corresponds to the structure or element of the claims. For example, it is not clear what corresponds to the "joining part", "proximal section", "distal section", etc.

Art Unit: 3738

With regard to claim 28, because there was not guidance as to how broadly to interpret "substantially the same as the width", the Examiner posits that the present claims are indefinite because one cannot determine the claims metes and bounds.

With regard to claim 34, the meaning of "non-parallel" is not clear because oblique angles were disclosed in the specification. It is not clear whether these terms have the same scope; i.e. it is clear what the scope of the claims are intended to be.

Claim Rejections Base Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Schnepf-Pesch et al (US 5,860,999). Schnepf-Pesch et al anticipate the claim language wherein the struts (7, 7') thereof are angularly offset and the connectors (4) meet all the claim limitations; Figure 2 reads on the claimed invention even though it is

Art Unit: 3738

partially expanded because it could clearly be expanded more; see the whole document, especially Figure 2 and the abstract.

With regard to claims 16-25, the Examiner notes the similarity to patented claims of Jang (US 5,954,743). However, in order to advance prosecution as far as before, and if, an interference is established, the Examiner decided to present this rejection.

Claim 34 is rejected under 35 U.S.C. 102(e) as being anticipated by Richter et al (US 6,156,052) wherein the connectors are shown as element (30) of Figure 2B; see the whole document.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-33 are rejected under 35 U.S.C. 102(e) as anticipated by Richter et al (US 6,156,052) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Richter et al (US 6,156,052) in view of Schnepf-Pesch et al (US 5,860,999). Richter et al anticipates the claim language where the connector struts to expansion struts ratio is inherently within the claim range because the connector struts are intended to give axial flexibility to the stent; see Figure 2A for example.

Alternatively, one could interpret the claim language as not being met because there is no explicit disclosure of the struts ratio as claimed. Schnepf-Pesch et al, however, teach that it was known to make similar stents with a certain number of connectors in order to provide flexibility; see the abstract. Hence, it is the Examiner's

Art Unit: 3738

position that it would have been obvious to adjust the connector properties or numbers in order to make the Richter et al more flexible so that it could be used in a curved part of the vasculature.

Claims 26-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz (US 5,102,417) wherein the ratio as claimed is met because the Palmaz device can be bent at the connector section; see the whole document.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738